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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Joseph R. BYRUM *et al.*

Appln. No.: 09/521,640

Filed: March 10, 2000

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Art Unit: 1631

Examiner: Michael L. Borin

Atty. Dkt. No.: 16517.128

Appeal No.: 2003-1666

Request for Suspension of Appeal

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the Board of Patent Appeals and Interferences ("Board") suspend action in the above-captioned appeal. The issues presented in the appeal involve the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112 and the sufficiency of the written description of these sequences. An appeal involving the utility of partial nucleic acid molecules is currently pending before the United States Court of Appeals for the Federal Circuit ("Federal Circuit"). The sufficiency of the written description has been decided by the Board under similar circumstances as the present appeal.¹

On September 23, 2002 Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on December 26, 2002 and waived oral hearing on July 22, 2004.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in *In re Fisher* (U.S. Appln No. 09/619,643, B.P.A.I. Appeal

¹ Rejections for the lack of sufficiency of the written description, have repeatedly been reversed by the Board in similar cases. See, Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

I hereby certify that the foregoing Request for Suspension of Appeal is being facsimile transmitted to the attention of the Board of Patent Appeals and Interferences, via facsimile number (703) 308-6200, and to the U.S. Patent and Trademark Office central facsimile number (703) 872-9306.

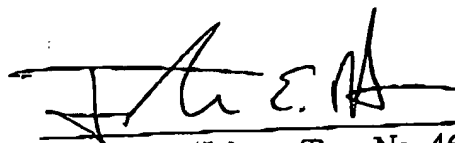
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No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112.²

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in the appeal, is sound practice. *See e.g.*, M.P.E.P. §1213, 8th Edition, Revision No. 2, at page 1200-31.

For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,



Thomas E. Holsten (Reg. No. 46,098)
David R. Marsh (Reg. No. 41,408)

Date: August 20, 2004

Of Counsel
Lawrence M. Lavin, Jr. (Reg. No. 30,768)
Thomas E. Kelley (Reg. No. 29,938)
Monsanto Company

ARNOLD & PORTER LLP
555 Twelfth Street, NW
Washington, DC 20004-2402
(202) 942-5000 telephone
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² The Board has upheld Examiners' utility rejections in similar appeals. *See, e.g.* Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

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Thomas E. Holsten
Thomas_Holsten@aporter.com202.942.5085
202.942.5999 Fax555 Twelfth Street, NW
Washington, DC 20004-1206

August 20, 2004

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Re: Requests for Suspension of Appeal

Dear Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office is a Request for Suspension of Appeal for each of the following applications:

1. Appeal No.: Not Yet Assigned/Conf. No. 6701
Serial No. 09/267,199, filed March 12, 1999
Applicants: Barkur G. BHAT *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with the Tocopherol Pathway
Attorney Docket No.: 16517.233
2. Appeal No.: 2003-1072
Serial No. 09/333,534, filed June 14, 1999
Applicants: Timothy W. CONNER *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.323
3. Appeal No.: 2003-1073
Serial No. 09/540,234, filed April 3, 2000
Applicants: Timothy W. CONNER *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.326
4. Appeal No.: 2003-1074
Serial No. 09/552,086, filed April 19, 2000
Applicants: Robert E. BUEHLER *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.324
5. Appeal No.: 2003-1666
Serial No. 09/521,640, filed March 10, 2000
Applicants: Joseph R. BYRUM *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.128

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6. Appeal No.: 2003-1939
Serial No. 09/333,535, filed June 14, 1999
Applicants: Joseph R. BYRUM *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.277
7. Appeal No.: 2004-1034
Serial No. 09/666,355, filed September 20, 2000
Applicants: Karen L. FINCHER *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.314
8. Appeal No.: 2004-1272
Serial No. 09/371,146, filed August 9, 1999
Applicants: Nordine CHEIKH *et al.*
Title: Annotated Plant Genes
Attorney Docket No.: 16517.032
9. Appeal No.: 2004-1273
Serial No. 09/637,086, filed August 11, 2000
Applicants: Karen L. FINCHER *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.285
10. Appeal No.: 2004-1275
Serial No. 09/540,235, filed April 3, 2000
Applicants: Dane K. FISHER *et al.*
Title: Nucleic Acid Sequences from *Cyanidium Caldarium* and Uses Thereof
Attorney Docket No.: 16517.276
11. Appeal No.: 2004-1406
Serial No. 09/553,094, filed April 18, 2000
Applicants: Scott E. ANDERSEN *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.272

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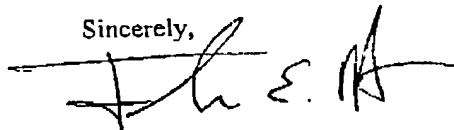
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12. Appeal No. 2004-1480
Serial No. 09/732,627, filed December 8, 2000
Applicants: Karen L. FINCHER *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.281
13. Appeal No.: 2004-1725
Serial No. 09/233,218, filed January 20, 1999
Applicants: Claire A. CAJACOB *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with the Tetrapyrrole
Pathway
Attorney Docket No.: 16517.231
14. Appeal No.: 2004-1773
Serial No. 09/421,106, filed October 15, 1999
Applicants: Joseph R. BYRUM
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Attorney Docket No.: 16517.142

It is respectfully requested that acknowledgement of receipt of these waivers be sent via return facsimile to the undersigned at 202-942-5999.

In the event that extensions of time are necessary to prevent abandonment of these patent applications, then such extensions of time are hereby petitioned. Appellants do not believe any fees are due in conjunction with these filings. However, if any fees are required in the present applications, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.001.

Sincerely,



David R. Marsh (Reg. No. 41,408)
Thomas E. Holsten (Reg. No. 46,098)

Enclosures

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ARNOLD & PORTER LLP

202.942.5000
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555 Twelfth Street, NW
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Re: Appeal Nos. 2003-1072, 2003-1073, 2003-1074, 2003-1666, 2003-1939, 2004-1034, 2004-1272,
 2004-1273, 2004-1275, 2004-1406, 2004-1480, 2004-1725, 2004-1773 and
 Application No. 09/267,199 (BHAT *et al.*) filed March 12, 1999 (Conf. No. 6701)
 Atty. Dkt. Nos.: 16517.323, 16517.326, 16517.324, 16517.128, 16517.277,
 16517.314, 16517.032, 16517.285, 16517.276, 16517.272,
 16517.281, 16517.231, 16517.142 and 16517.233

See the attached. Please acknowledge receipt via return facsimile.

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